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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/738,372	12/15/2000	Min Jiang	IMRAA.013DV1	1781

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KNOBBE MARTENS OLSON & BEAR LLP
620 NEWPORT CENTER DRIVE
SIXTEENTH FLOOR
NEWPORT BEACH, CA 92660

EXAMINER

ZAHN, JEFFREY N

ART UNIT	PAPER NUMBER
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2881

DATE MAILED: 12/19/2001

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/738,372

Applicant(s)

JIANG ET AL.

Examiner

Jeffrey N Zahn

Art Unit

2881

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period of Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 22-28,33 and 34 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 22-28 and 33-34 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). ____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____ 6) ☐ Other: ____

DETAILED ACTION

Acknowledgments/Summary

The Amendment/Arguments filed by the Applicant on 27 September 2001 have been entered as Paper No. 7. Accordingly, Claim 27 has been amended and Paper No. 7 has been considered for purposes of this examination. Currently, Claims 22-28 and 33-34 are pending in this application. Claims 22-28 and 33-34 are rejected for the reasons discussed below.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 22-34 are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential steps, such omission amounting to a gap between the steps. See MPEP § 2172.01. The omitted steps are: (1) pumping a gain medium within a resonant Fabry-Perot laser cavity; (2) generating Q-switched mode-locked laser pulses using a saturable absorber located within said resonant Fabry-Perot optical cavity; (3) absorbing said Q-switched laser pulses by insertion of a Two-Photon Absorber within the said resonant Fabry-Perot optical cavity; and (4) outputting a cw mode-locked laser pulse from the said resonant Fabry-Perot optical cavity.

These steps are essential because they are (1) necessary to generate a cw mode-locked laser pulses as disclosed by the applicant and (2) these steps are not obvious to someone of skill in the art of lasers, as related to claim interpretation, without reference to the specification.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 22-28, and 33-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jacobovitz-Veselka et al. in view of Hordvik.

Regarding Claims 22-26, 28, and 33-34, Jacobovitz-Veselka et al. discloses a method of generating mode-locked Q-switched laser pulses (col. 2, lines 55-64) that includes pumping a gain medium (12) disposed within a laser cavity (11 & 15). In addition, Jacobovitz-Veselka et al. discloses a method of absorbing optical radiation within a Fabry-Perot structure (col. 5, lines 11-27) that includes a saturable absorber (14). Jacobovitz-Veselka et al. lacks the step of suppressing Q-switching.

Hordvick teaches the use of Two-Photon Absorption to suppress Q-switching as a means to enable pulse stretching (Abstract; see also col. 1, 2nd para. of Introduction). It would have been obvious at the time of the invention to someone of ordinary skill in the art of lasers to modify Jacobovitz-Veselka et al. to include absorbing Q-switched laser pulses using a Two-Photon Absorber to lengthen the pulses. It is well known in the art of lasers that increasing the pulse length of a laser pulse is valuable for many laser applications that involve increased peak power.

Regarding Claim 27, where the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine

Art Unit: 2881

experimentation. In re Aller, 220 F.2d 454, 456 (CCPA 1955). Here, the applicant has specified a step of resonating light within the Fabry-Perot structure; the prior art discloses, i.e. Jacobovitz-Veselka et al. that includes a Fabry-Perot structure. In addition, it is inherent that this structure must resonate at a particular frequency that depends on the length of the cavity.

Response to Arguments

Applicant's arguments filed 28 September 2001 have been fully considered but they are not persuasive.

Regarding 35 U.S.C. 112, second paragraph rejections:

Applicant makes the argument that "Applicant did not disclose in the specification of this application or in the statements of record that the elements identified by the Examiner are 'essential.'" (page 2, last para.) Therefore, all rejections based on "missing essential elements" must be withdrawn.

The determination of "essential elements" required to be claimed to support the enablement of the claims and to adequately describe the metes and bounds of the invention to one of ordinary skill in the art is not a subjective test on the part of the Applicant. The standard is what "one of ordinary skill in the art" would understand to be essential elements.

Regarding 35 U.S.C. 103 rejections:

Applicant argues that the prior art references Jacobovitz-Veselka et al. and Hordvick et al. lack a method of generating a "CW mode-locked laser pulses."

Therefore, these references alone or in combination do not support a 35 U.S.C. 103 rejection. (page 3, line 8)

In response to applicant's arguments, the recitation of "generating CW mode – locked laser pulses" has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951). Furthermore, Claims 22-28 and 33-34 do not recite adequate steps and inter-step relationships to support a method of generating CW mode-locked laser pulses"; therefore, the preamble has not been given any patentable weight.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of


Art Unit: 2881

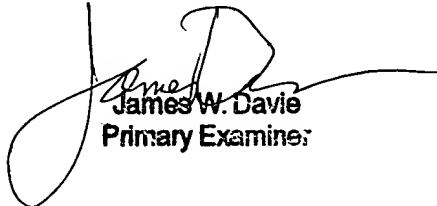
the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey N Zahn whose telephone number is 703-305-3443. The examiner can normally be reached on M-F: 8:30-5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Paul M Dzierzynski can be reached on 703-308-4822. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-7722 for regular communications and 703-308-7722 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0956.


Jeffrey Zahn
December 14, 2001


James W. Davie
Primary Examiner